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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,772	07/13/2001	Linda Angelone	GFM-00201	3503
7590 Nixon Peabody LLP Clinton Square P O Box 31051 Rochester, NY 14603				
09/02/2008				
EXAMINER				
FRENEL, VANEL				
ART UNIT		PAPER NUMBER		
3687				
MAIL DATE		DELIVERY MODE		
09/02/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/905,772

Applicant(s)

ANGELONE ET AL.

Examiner

VANEL FRENEL

Art Unit

3687

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 75-101 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 75-101 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/05/08 has been entered.

Notice to Applicant

2. This communication is in response to the RCE filed on 06/05/08. Claims 1-74 have been cancelled. Claims 75-101 have been newly added. Claims 75-101 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 75-101 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 75-101 recite a process comprising the steps of performing, allocating and providing. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S.

780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 75-101 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. (5,704,045) in view of Kern (6,604,080).

(A) As per claim 75, King discloses a method for performing the assessment of the at least one insolvency fund based on one or more factors when the determining determines the assessment is needed (See King, Col.5, lines 45-67); allocating a member assessment amount to each of the plurality of insurers based on the performed assessment (See King, Col.10, lines 1-29); and providing notification of the allocated member assessment amount to each of the plurality of insurers (See King, Col.5, lines 45-67; Col.6, lines 15-63).

King does not explicitly disclose that the method having an assessment comprising: determining when an assessment of at least one insolvency fund associated with a plurality of insurers is needed based on one or more triggers.

However, this feature is known in the art, as evidenced by Kern. In particular, Kern suggests that an assessment comprising: determining when an assessment of at least one insolvency fund associated with a plurality of insurers is needed based on one or more triggers (See Kern, Col.19, lines 55-67 to Col.20, line 19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Kern within the system of King with the motivation of providing under state law, the insurance company is liable to the injured employee. If the insurance company should fail, then the state guarantee fund becomes liable (See Kern, Col.19, lines 55-67).

(B) As per claim 76, Kern discloses the method wherein the one or more triggers comprise at least one of an insolvency of at least one of the plurality of insurers, a size of an insolvency of at least one of the plurality of insurers above an insolvency amount threshold, a current total amount in the at least one insolvency fund below a threshold amount, and an expiration of a first set period of time (See Kern, Col.20, lines 1-20).

(C) As per claim 77, King discloses the method wherein the insolvency amount threshold comprises an amount needed to play existing claims (See King, Col.1, lines

46-59).

(D) As per claim 78, King discloses the method wherein the allocating the member assessment amount further comprising: determining a member ratio for the allocating the member assessment amount to each of the plurality of insurers (See King, Col.5, lines 45-67; Col.6, lines 15-63); and applying each of the determined member ratios to a gross assessment amount obtained from the performed assessment to obtain the member assessment amount for each of the plurality of insurers (See King, Col.5, lines 45-67; Col.6, lines 15-63).

(E) As per claim 79, Kern discloses the method wherein the one or more factors comprise at least one of one or more state rules and one or more state statutes (See Kern, Col.23, lines 48-67 to Col.3, line 27).

(F) As per claim 80, King discloses the method further comprising: receiving approval of the allocated member assessment amounts from each of the plurality of insurers (See King, Col.5, lines 45-67; Col.6, lines 15-63); and finalizing the allocated member assessment amounts based on the received approval (See King, Col.5, lines 45-67; Col.6, lines 15-63).

(G) As per claim 81, King discloses the method further comprising: receiving at least one of new data and adjusted data relating to at least

one of the performing the assessment and the allocating the assessment (See King, Col.19, lines 12-27); and adjusting the allocating the member assessment amount for at least one of the plurality of insurers based on the at least one of new data and adjusted data (See King, Col.17, lines 21-45).

(H) As per claim 82, King discloses the method wherein the adjusting further comprises: recalculating at least one new member ratio for allocating to at least one of the plurality of insurers (See King, Col.19, lines 12-27); and applying the at least one new determined member ratio to a gross assessment amount obtained from the performed assessment to obtain the member assessment amount for at least one of the plurality of insurers (See King, Col.1, lines 46-59).

(I) As per claim 83, King discloses the method wherein the adjusting further comprises: receiving a reversal notification from at least on of the plurality of insurers (See King, Col.5, lines 45-67; Col.6, lines 15-63); and reinstating the prior member assessment amount to each of the plurality of insurers in response to the received reversal notification (See King, Col.5, lines 45-67; Col.6, lines 15-63).

(J) Claim 84 differs from claim 75 by reciting a computer readable medium having stored thereon instructions for performing an assessment comprising machine executable code which when executed by at least one processor, causes the processor to perform steps comprising:

As per this limitation, it is noted that Kern determining when an assessment of at least one insolvency fund associated with a plurality of insurers is needed based on one or more trigger (See Kern, Col.19, lines 55-67 to Col.20, line 19) and King discloses performing the assessment of the at least one insolvency fund based on one or more factors when the determining determines the assessment is needed (See King, Col.5, lines 45-67); allocating a member assessment amount to each of the plurality of insurers based on the performed assessment; (See King, Col.10, lines 1-29); and providing notification of the allocated member assessment amount to each of the plurality of insurers (See King, Col.5, lines 45-67; Col.6, lines 15-63).

Thus, it is readily apparent that these prior art systems utilize a computer readable medium having stored thereon instructions for performing an assessment comprising machine executable code which when executed by at least one processor, causes the processor to perform their specified function.

The remainder of claim 84 is rejected for the same reasons given above for claim 75, and incorporated herein.

(K) As per claim 93, King discloses an assessment processing system that performs the assessment of the at least one insolvency fund based on one or more factors when the determining determines the assessment is needed and allocates a member assessment amount to each of the plurality of insurers based on the performed assessment (See King, Col.10, lines 1-29); and a communication system that provides notification of the allocated member assessment amount to each of the plurality of

insurers (See King, Col.5, lines 45-67; Col.6, lines 15-63).

King does not explicitly disclose a system comprising: a triggering system that determines when an assessment of at least one insolvency fund associated with a plurality of insurers is needed based on one or more triggers.

However, this feature is known in the art, as evidenced by Kern. In particular, Kern suggests a system comprising; a triggering system that determines when an assessment of at least one insolvency fund associated with a plurality of insurers is needed based on one or more triggers (See Kern, Col.19, lines 55-67 to Col.20, line 19).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Kern within the system of King with the motivation of providing under state law, the insurance company is liable to the injured employee. If the insurance company should fail, then the state guarantee fund becomes liable (See Kern, Col.19, lines 55-67).

(L) Claims 85-92 and 94-101 recite the underlying process steps of the elements of claims 76-83, respectively. As the various elements of claims 76-83 have been shown to be either disclosed by or obvious in view of the collective teachings of King and Kern, it is readily apparent that the system disclosed by the applied prior art performs the recited underlying functions. As such, the limitations, recited in claims 85-92 and 94-101 are rejected for the same reasons given above for method claims 76-83, and incorporated herein.

6. Applicant's arguments filed on 06/05/08 with respect to claims 75-101 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not the applied prior art teaches system and methods for computing to support decomposing property into separately valued components (5,802,501).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANEL FRENEL whose telephone number is (571)272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Vanel Frenel/

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September 01, 2008